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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,070	11/26/2003	Kouji Uno	SN-US035135	7771

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EXAMINER

LORENCE, RICHARD M

ART UNIT	PAPER NUMBER
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3681

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/721,070

Applicant(s)

UNO ET AL.

Examiner

Richard M. Lorence

Art Unit

3681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 5, 10-12 and 30-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9 and 13-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/21/04 & 4/21/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This is the first Office action on the merits of Application No. 10/721,070 filed on November 26, 2003. Claims 1-49 are currently pending.

Election/Restrictions

Applicant's election without traverse of the species of Figures 10-14 in the reply filed on March 1, 2005 is acknowledged. Claims 5, 10-12 and 30-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the reference numeral "10" mentioned in the description in line 1 of paragraph [0041].

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because Figure 2 includes the reference characters "16a" and "20a" which are not mentioned in the description.

The drawings are objected to because in Figure 3 the reference numeral 44 has been used to designate both the gripping body and the outer bracket cover. The gripping body should be designated by the reference numeral "40" rather than - - 44- - .

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

In lines 1 and 6 of paragraph [0050] "electrical" should read - - electrically - -.

In lines 4 and 5 of paragraph [0050] "conductor" should read - - conductors - -.

Appropriate correction is required.

The specification is further objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). In particular, claim 1 recites that an electrical shift control switch is fixedly mounted to “at least one of the inner side wall, the outer side wall, the front wall and the bottom wall of the brake lever bracket”. The specification is only seen to provide antecedent for the mounting of the switch on the inner side wall of the bracket (paragraph [0049], lines 1-2]. There does not appear to be any description of an arrangement where a switch is mounted to any of the other walls of the bracket.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 14, 15, 18 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 9 and 29, it is not clear which of the disclosed structure corresponds to the claimed “clicking element”. As best understood the audible sound occurs as a result of interaction between the elements 90a and either 84a or 84c, or between the elements 90b and either 84b or 84b. However it does not appear that there is a single “clicking element” as the claims imply.

In each of claims 14 and 15 there is no clear antecedent basis for the recited "first rotationally operating axis" since claim 13, from which each of these claims depend, is written in the alternative format which does not necessarily require a switch mounted on the brake lever which rotates about a first rotationally operating axis.

Furthermore claim 14 is believed to be incorrect. In the case where the switch is mounted to the brake lever, the operating axis (A2 in Figure 3) lies in the brake operating plane P as described in lines 3-4 of paragraph [0054]. Accordingly it is not clear how the axis can be said to intersect the plane.

As to claim 18 the plane referred to in line 5 along which the switch moves and which is angled with respect to the brake operating plane is not entirely clear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Fukuada '036 which discloses an electrical shift and brake control device in Figure 5 including the brake lever bracket 16, brake lever 15 and the electrical shift control switch 14DF or 14DR mounted on the bracket as described at column 4, lines 3-9, and the switch 14U mounted on the brake lever. Also note Figure 2 which shows the biasing

element 20 which urges the switch to a neutral position as described at column 2, line 65 to column 3, line 2, the movable contacts 24D and 24U and the stationary contacts 25D and 25U as described at column 3, lines 9-16.

Claims 1-4, 7-9, 13, 17, 19, 20 and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Watarai '649 which discloses an electrical shift and brake control device in Figures 1-3 including the brake lever bracket 9, brake lever 7 and the electrical shift control switch 10 mounted on the bracket to rotate about an axis 11 perpendicular to the operating plane of the lever. Watarai also shows the return spring 12, contacts 13a, 13b and clicking elements 10b, 9a, 9b.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 14-16, 18 and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watarai '649 in view of Fukuda '036. Watarai does not disclose the additional switch mounted on the lever. Fukuda suggests providing gear shift switches on the lever as well as on the bracket in order to permit upshifting while the rider's hand is on the brake lever and downshifting while the rider's hand is on the handlebar or bracket (column 1, lines 40-59). It would have been obvious to one having ordinary skill

in the art at the time the invention was made to provided the shift and brake control device of Watarai with switches provided on both the bracket and the lever in view of the suggestion of Fukuda.

Prior Art Citation


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Each of the prior art references listed on the forms PTO-1449 filed with the Information Disclosure Statements filed on January 21, 2004 and April 21, 2004 has been considered, except for the Mavic Catalog cited in the January 21 submission. The Mavic Catalog has been placed in an artifact folder which currently cannot be located. Applicant is requested to provide another copy of the catalog or at least the relevant pages thereof. Any inconvenience is regretted.

The examiner further cites Mimura '983, Tokuda et al. '190, Horiuchi '786 and Dal Pra' '567 each of which show switches for controlling the gear ratio of a bicycle. Dal Pra' '567 corresponds to the earlier '712 publication cited by applicant in the IDS filed on January 21, 2004.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard M. Lorence whose telephone number is (703) 308-3062. The examiner can normally be reached on Mondays through Fridays from 9:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (703) 308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Richard M. Lorence
Primary Examiner
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Lorence/rml